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CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP			EXAMINER	
STEVEN M. GREENBERG			MYEERS, MATTHEW S	
950 PENINSULA CORPORATE CIRCLE			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/972,403	<b>Applicant(s)</b> ALBAZZ ET AL.
	<b>Examiner</b> MATTHEW S. MEYERS	<b>Art Unit</b> 3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

#### Status

1) Responsive to communication(s) filed on 03 April 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,3,5-11,13-19,21-25,27,29-35 and 37-40 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,3,5-11,13-19,21-25,27,29-35 and 37-40 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

1. In view of the Supplemental Appeal Brief filed on 04/03/2008, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689.

***Priority***

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 9-16 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

3. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the

method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

4. Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be preformed without the use of a particular apparatus. Thus, claims 9-16 are non-statutory since they may be preformed within the human mind.

5. Claims 25-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

6. Claims 25-32, drawn to a processing system, fail to satisfy the requirements for statutory subject matter eligibility because they are considered to be drawn merely to the production and/or manipulation of non-functional descriptive material, effecting no "useful, concrete, and tangible result." To be statutory, a computer program must be: (1) coupled with or combined with some statutory physical structure, which is indeed the case with the instant claims, but also, (2) produce or effect some useful, concrete, and tangible result, which is in fact not *necessarily* the case with the instant claims, since the claims read on just a processing system (non-functional descriptive material), as opposed to machine executable instructions (functional descriptive material), which could potentially effect some useful, concrete, and tangible result. It has been held that such claims, even if the non-functional descriptive material is claimed in combination with a computer-readable medium, are considered to comprise non-statutory subject matter, for merely manipulating an abstract idea. *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994). See MPEP §2106.01(l).

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1,3,5-11,13-19,21-25,27,29-35 and 37-40** are rejected under 35 U.S.C. 102(b) as being anticipated by Conklin et al. (U.S. 6,338,050) (Hereinafter referred to as Conklin).

4. With respect to **Claims 1, 9, 17, 25, and 33:**

Conklin discloses a system, method, and computer program product of workflow control of contractual activities under a contract comprising a predefined set of terms and conditions (Conklin col. 14, lines 30-33, “It is an aspect of the present invention that it provides comprehensive iterative bargaining abilities for both buyers and sellers that enable them to negotiate all the terms and conditions of a transaction--not just the price.”, comprising the steps of:

storing the contract terms and conditions (Conklin col. 14, lines 1-29, “The system maintains internal databases...”),

receiving information (Conklin col. 14, lines 1-29, “All this is done through a multivariate negotiations engine system operated at the system provider's Internet site...”), and

referencing the terms and conditions of the contract to process the information and generate user interfaces in response (Conklin col. 14, lines 1-29, "...allows a buyer/participant to search and evaluate seller information..."), and communicating a user interface to a contracting party (Conklin col. 17, lines 14-16, "communicating over telecommunications link" and col. 14, lines 1-29, "...allows a buyer/participant to search and evaluate seller information, propose and negotiate orders and counteroffers that include all desired terms..."), wherein

the user interface displays selected information based on terms and conditions in the contract (Conklin col. 14, lines 1-29, "...allows a buyer/participant to search and evaluate seller information, propose and negotiate orders and counteroffers that include all desired terms...") (Examiner notes that this claimed limitation is not present in claims 9, 17, and 33 but included for grouping purposes)

the contract is generated by:

storing at least one compilation of business rules comprising a plurality of rules available to be selected for inclusion in the contract, storing at least one terms and conditions set containing parameters corresponding to selected rules from the compilation of business rules, generating links between the compilation of business rules and the terms and conditions set to generate specific terms and conditions to be embodied in the contract, and interlocking the compilation of business rules, the terms and conditions set and the links to lock the contract

(Conklin Col. 19, lines 38-56, "Sponsor 06 also monitors activity, collects fees, establishes standards or rules (or both) for the community, and promotes successes." and Figs, 4a and 4b and col. 32 lines 7-35) (Examiner notes that it is inherent within Conklin, that the links have been generated and interlocked (joined) between a seller and sponsor through logical interrelationships amongst the various databases in a community.)

5. With respect to **Claims 2 and 26:**

Cancelled

6. With respect to **Claims 10, 18, and 35:**

Conklin discloses the user interface displays selected information based on terms and conditions in the contract (Conklin col. 14, lines 1-29, "...allows a buyer/participant to search and evaluate seller information, propose and negotiate orders and counteroffers that include all desired terms...").

7. With respect to **Claims 3, 11, 19, 27, and 35:**

Conklin discloses in which the contract contains representation criteria comprising product selection criteria or products exclusion criteria, or both, and the user interface displays a filtered product list comprising a subset of products from a master product list (Conklin col. 19, lines 57-60, "Buyer processes shown in FIG. 1g include search and evaluate processes, which enable a prospective buyer to find companies and their products in the community and investigate their prices, terms and service offerings.").

The data in which the contract contains is non-functional descriptive data.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Exemplary "functional descriptive material" consists of data structures and computer programs, which impart functionality when employed as a computer component. "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384-85,217 USPQ at 403; see also *Diamond v. Diehr*, 450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the data in which the contract contains adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the data in which the contract contains does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

8. With respect to **Claims 4, 12, 20, 28, and 36:**

Cancelled.

9. With respect to **Claims 5, 13, 21, 29, 37:**

Conklin discloses storing at least one product list filter for generating a list of a specified subset of products from a master list of products, and generating links between the product list filter, the terms and conditions set and the master list of products (Conklin col. 21, lines 37-43, "Unique id's feature is used to insure the proper data is found and transmitted. That is, the present invention associates unique identifiers (id's) with each sponsor, participant, and type of data or transaction. Since database functions are integrated directly with the other functions of the invention, faster processing and updating of the database is enabled.").

The data in which the product list is non-functional descriptive data.

10. With respect to **Claims 6, 14, 22, 30, and 38:**

Conklin discloses the product list filter comprises a plurality of tiers, each tier generating a list of a different subset of products (Conklin Fig 1g, item 70, "Search & Evaluate").

The data in which the product list is non-functional descriptive data.

11. With respect to **Claims 7, 15, 23, 31, and 39:**

Conklin discloses the contract comprises dynamic elements which can be unilaterally altered by a contracting party (Conklin col. 23, lines 37-53, "participant proposing terms to another participant on an initiating terminal (or desktop computer or workstation, etc.) over the Internet through multivariate negotiations engine system, thereby creating a communications path which is ultimately directed by multivariate negotiations engine system over the Internet to the destination terminal at which the selected other participant is active.").

The data in which the contract contains is non-functional descriptive data.

12. With respect to **Claims 8, 16, 24, 32, and 40:**

Conklin discloses the product list filter is a dynamic element (Conklin col. 14, lines 1-29, "...allows a buyer/participant to search and evaluate seller information, propose and negotiate orders and counteroffers that include all desired terms...").

The data in which the product list is non-functional descriptive data.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW S. MEYERS whose telephone number is (571)272-7943. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew S. Meyers/  
Examiner, Art Unit 3689

/Janice A. Mooneyham/  
Supervisory Patent Examiner, Art Unit 3689